

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TCL CORPORATION; TCL COMMUNICATION TECHNOLOGY
HOLDINGS, LTD.; TCT MOBILE LIMITED; TCT MOBILE INC.; AND
TCT MOBILE (US) INC.

Petitioners,

v.

TELEFONAKTIEBOLAGET LM ERICSSON

Patent Owner.

Case IPR2015-01674

U.S. Patent No. RE43,931

PATENT OWNER'S PRELIMINARY RESPONSE

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Patent Owner Telefonaktiebolaget LM Ericsson ("Patent Owner" or "Ericsson") respectfully submits this Preliminary Response to Petitioners' TCL Corporation, TCL Communication Technology Holdings, Ltd., TCT Mobile Limited, TCT Mobile Inc., and TCT Mobile (US) Inc. (collectively, "TCL") *inter partes* review petition of U.S. Patent No. RE43,931 ("the '931 patent"). This filing is timely under U.S.C. § 313 and 37 C.F.R. 42.107 because it is within three months of the August 21, 2015 date of the Notice granting the Petition a filing date. (See Paper No. 3.)

I. INTRODUCTION

Patent Owner respectfully submits that *inter partes* review of the '931 patent should not be instituted in this matter because the grounds that Petitioners have presented in the instant Petition are redundant to the grounds presented in Petitioners' concurrently-filed petition IPR2015-01602 ("the 1602 Petition").¹ Specifically, the instant Petition and the 1602 Petition use references with substantially the same teachings to challenge the same set of claims of the '931

¹ Patent Owner notes that TCL has filed 8 separate petitions against the '931 patent.

patent. Thus, on their face, the petitions are “horizontally redundant” under Board precedent. Because Petitioners have not even attempted to explain how each group of references is superior to the other in at least one respect in connection with the alleged obviousness of the challenged claims, the Board should not institute review on both grounds. Either the instant Petition should be denied, or the 1602 Petition should be denied.

Further, the Board should not institute *inter partes* review of claims 1-12 and 15 of the ‘931 patent because TCL failed to set forth a *prima facie* case that the prior art could be successfully combined to result in the limitations of claims 1-12 and 15. “The Director may *not* authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition...shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged...” 35 U.S.C. § 314(a) (emphasis added). With this fatal flaw, TCL’s proposed grounds for *inter partes* review do not—and cannot—give rise to a reasonable likelihood that TCL will prevail with respect to claims 1-12 and 15. As such, the Petition should be denied.

II. THE PROPOSED GROUNDS ARE REDUNDANT

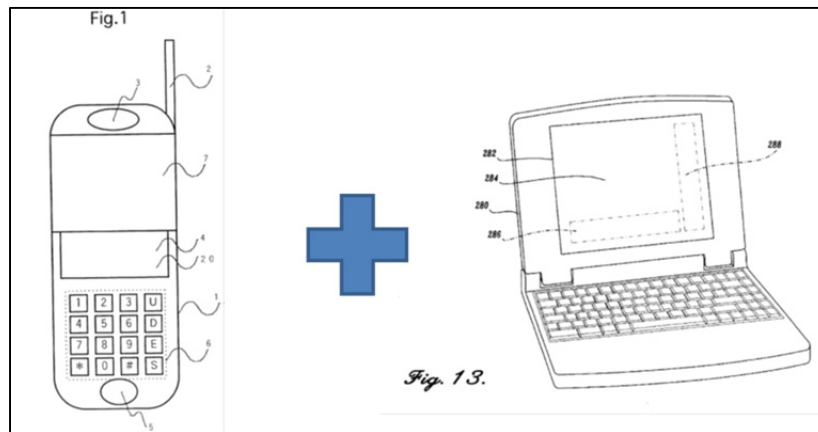
The Board has explained that “multiple grounds, which are presented in a redundant manner by a petitioner who makes no meaningful distinction between

them, are contrary to the regulatory and statutory mandates, and therefore are not all entitled to consideration.” *Liberty Mutual Ins. Co. v. Progressive Casualty Ins. Co.*, Case CBM2012-00003, slip op. at 2 (PTAB Oct. 25, 2012) (Paper No. 7). *See also Canon Inc. v. Intellectual Ventures I LLC*, Case IPR2014-00535, -00536, -00537 (PTAB Sep. 24, 2014) (Paper No. 9) (applying redundancy across different petitions based on different references); *Ultratec, Inc. v. Sorenson Commc’ns., Inc.*, Case IPR2013-00288 (PTAB Jan. 10, 2014) (Paper No. 23). In particular, “horizontal” redundancy occurs where “a plurality of prior art references [are] applied not in combination to complement each other but as distinct and separate alternatives.” *Liberty Mutual*, slip op. at 3.

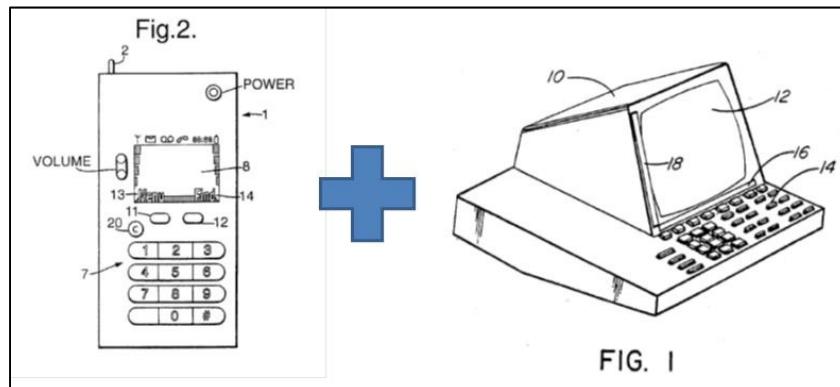
Taking the 1602 and 1674 Petitions together, as in *Liberty Mutual* the references relied on “provide essentially the same teaching to meet the same claim limitation, and the associated arguments do not explain why one reference more closely satisfies the claim limitation at issue in some respects than another reference, **and** vice versa.” *Id.* (emphasis in original). “Because the references are not identical, each reference has to be better in some respect or else the references are collectively horizontally redundant.” *Id.*

In both the instant Petition and the 1602 Petition, Petitioners assert that claims 1-12 and 15 of the ‘931 patent are unpatentable as obvious. In the 1602

Petition, Iwata is the primary reference teaching a mobile telephone, and Stephan is the secondary reference relied upon for touch-sensitive strip technology. In the instant Petition, Palatsi is the primary reference teaching a mobile telephone, and Moore is the secondary reference relied upon for touch-sensitive strip technology. A visual comparison of the asserted embodiments in the 1602 and 1674 petitions are illustrated below.



(Portable Telephone of Iwata and Terminal of Stephan.)



(Portable Telephone of Palatsi and Terminal of Moore.)

Accordingly, the instant 1674 Petition and the 1602 Petition both present substantially the same prior art and arguments, leading to an archetypal “horizontal redundancy” situation. *Cf. Liberty Mutual; Ultratec, supra.*

Because the grounds of the instant 1674 Petition and the grounds of the 1602 Petition are horizontally redundant, it is Petitioners’ burden to “explain why one reference more closely satisfies the claim limitation at issue in some respects than another reference, **and** vice versa.” *Liberty Mutual*, slip op. at 3 (emphasis in original). Petitioners have not done so.

In this case, the Petitioners identify feature “1d” of Claim 1 in both Petitions as follows: “a contact-sensitive transducer, supported by the housing and having a contact-sensitive surface disposed at said front surface, which produces an output signal in response to moving contact of an object along the contact-sensitive surface of the contact-sensitive transducer.” (1602 at 23 and 1674 at 27.) The Petitioners rely on Iwata and Stephan to disclose the feature “1d” of Claim 1 in the 1602 Petition, and rely on Palatsi and Moore to disclose the feature “1d” in the instant Petition.

The instant Petition attempts to assert that the proposed grounds are not redundant to the grounds presented in the 1602 Petition. (Petition at 3-4.) One stated reason for the lack of redundancy is based on two different interpretations of

the phrase “contact-sensitive transducer.” However, both Petitions include the same identical proposed claim interpretation of the phrase “contact-sensitive transducer.” (1602 at 10-12 and 1674 at 11-13.) Therefore, it is clear that at least one of the Petitions is redundant if the Petitioner's own proposed claim interpretation of the phrase “contact-sensitive transducer” is accepted.

Also, the instant Petition states “Furthermore, Iwata more strongly suggests using moving contact-based scrolling to navigate large amounts of data on a display using visual “scroll bars,” whereas Palatsi describes a mobile telephone having more limited capabilities that could be accomplished via the push/touch sensor “buttons” that are already disclosed therein.” (Petition at 4.) However, the 1602 Petition still specifically relies on Stephan to disclose the feature of a contact-sensitive transducer producing an output signal “in response to *moving contact* of an object along the contact-sensitive surface of the contact-sensitive transducer.” (1602 at 25.) Therefore, the alleged stronger suggestion of Iwata in disclosing moving contact-based scrolling is irrelevant because the Petitioner still treats the feature “1d” of claim 1, which includes the above-noted recitation of claim 1 which recites the phrase “moving contact,” as requiring a secondary reference for both Iwata and Palatsi.

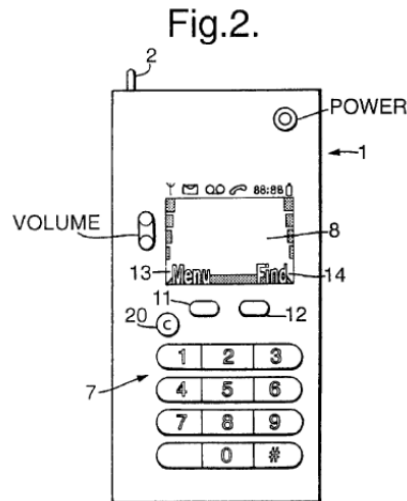
Accordingly, Petitioners have utterly failed to carry their burden of showing no horizontal redundancy between the grounds presented in the instant Petition and the grounds presented in the 1602 Petition. *See, e.g., Liberty Mutual; Ultratec, supra.* Accordingly, either the instant Petition should be denied, or the 1602 Petition should be denied.

III. OVERVIEW OF THE PRIOR ART

TCL proposed two separate grounds of rejections against various claims of the '931 patent in its Petition. In Ground 1, claims 1-11 and 15 were asserted to be obvious over U.S. Patent No. 5,892,475 to Palatsi et al. (Ex. 1087, "Palatsi") in view of U.S. Patent No. 4,566,001 to Moore et al. (Ex. 1012, "Moore"). In Ground 2, claim 12 was asserted to be obvious over Palatsi in view of Moore and further in view of EP Patent Application No. 0721272A2 to Tiilikainen et al. (Ex. 1088, "Tiilikainen").

A. Summary of Palatsi

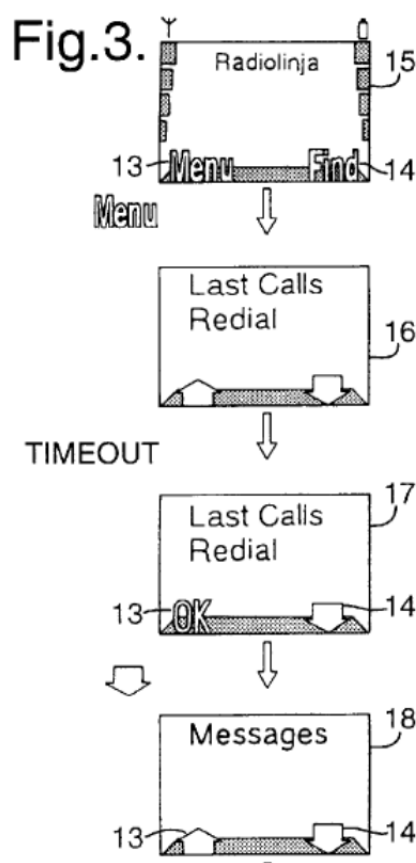
Palatsi discloses a user interface for a telephone device. (Ex. 1087, at Abstract.) Palatsi describes a need for portable, hand-held, telephones to be smaller, which makes it necessary to reduce the size of their keypads. (*Id.* at 1:5-28.) An embodiment of Palatsi is shown in Fig. 2 below.



The portable telephone in Fig. 2 of Palatsi includes two “soft” keys 11 and 12 disposed above a keyboard 7. The functions of the “soft” keys vary from time to time and the current functions are indicated by corresponding soft key zones 13 and 14 of the display. (*Id.* at 2:18-37.)

Figs. 3 and 4 illustrate the operation of the telephone by showing a series of pictures of the telephone's display in successive modes, as a user moves through the menu structure. (*Id.* at 2:47-50.) Palatsi describes that initially in the scroll-and-select menu mode the soft keys are marked by up and down arrows in the soft key zones and can be used to scroll through the menu options. (*Id.* at 2:63-66.) Thus, pressing key 11 causes the menu item preceding the currently-displayed one to be displayed and pressing key 12 causes the succeeding item to be displayed. (*Id.* at 2:66 to 3:2.) One of the objectives of Palatsi is to avoid using dedicated

arrow keys and a separate “select” key. (*Id.* at 2:43-46.) Thus, as illustrated in Fig. 3 below, Palatsi describes that the processor of the telephone monitors the time period since either of the soft keys was last pressed. (*Id.* at 3:2-4.) When a certain set time has elapsed, the soft key zone 13 corresponding to key 11 changes to display “OK.” (*Id.* at 3:4-6.) Pressing key 11 will then select the currently-displayed menu item and cause the processor to take the appropriate action corresponding to that item. (*Id.* at 3:7-9.)



Palatsi further describes that rather than having one or more keys as the input means the telephone could have, for example, one or more touch sensors,

sound sensors (actuated by sound) or motion sensors (actuated by motion or acceleration) and/or proximity sensors. (*Id.* at 4:16-20.) Palatsi further describes that each input device is preferably a binary input device having two states: actuated and not actuated. (*Id.* at 4:20-22.)

B. Summary of Moore

Moore discloses a display terminal which has touch strips extending along the adjacent and horizontal edges of the screen. (Ex. 1012 at Abstract.) Fig. 1 of Moore bellows shows a terminal that has a cathode ray tube (CRT) unit 10 with a rectangular screen 12, a keyboard 14, and extending horizontally and vertically along two edges of a bezel surrounding the rectangular screen are touch sensitive strips 16 and 18 respectively. (*Id.* at 2:15-22.)

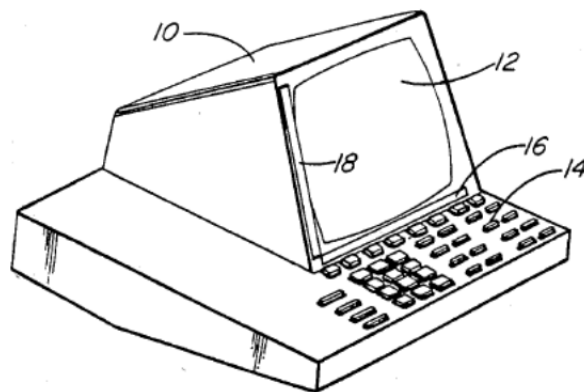


FIG. 1

The vertical and horizontal touch strips are described as having identical construction and in use each has a voltage output which is representative of the distance along it at which it is touched. (*Id.* at 2:22-25.)

Fig. 2 of Moore shown below illustrates that each of the touch strips, which operate on a voltage dividing principle has a flexible conductive strip 20 overlaying a resistive substrate 22. (*Id.* at 2:26-29.) The conductive strip and the substrate are normally separated from one another by an insulating frame 24 but can be locally brought together by pressing the strip downwardly at a desired location along the strip. (*Id.* at 2:29-33.) A voltage gradient is established along the resistive substrate by applying voltages V^+ , and V^- through resistors R to electrodes contacting the substrate ends. (*Id.* at 2:33-36.)

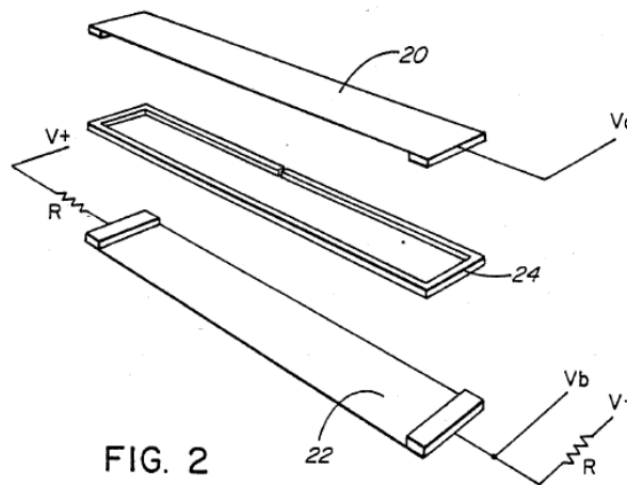


Fig. 3 of Moore is shown below, and it shows a block diagram of the hardware used in the terminal.

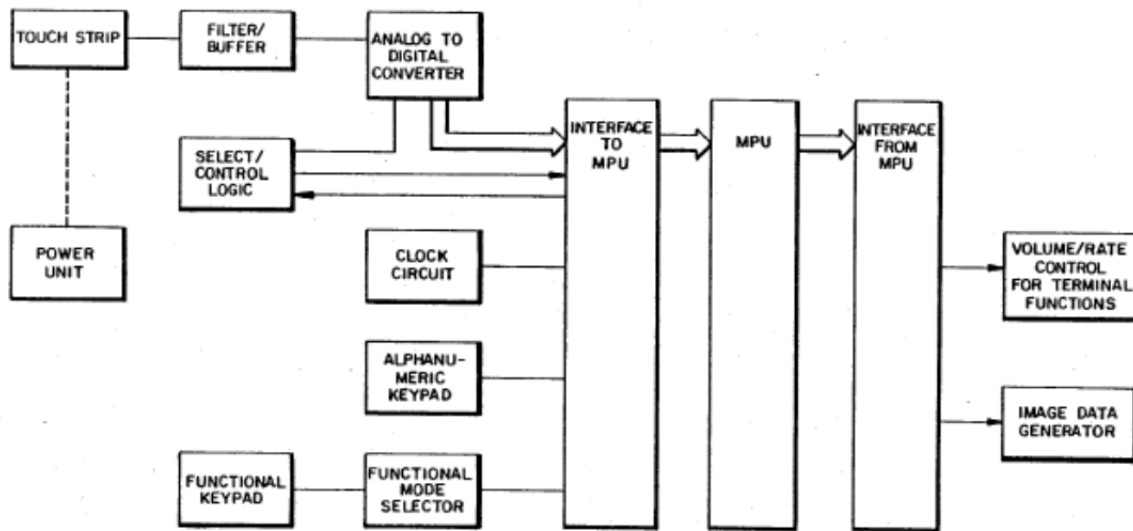


FIG. 3

Moore describes that the touch strip has a power supply to establish the voltage gradient along the resistive substrate. (*Id.* at 2:37-39.) The output of the touch strip is taken to the input of a filter/buffer unit and the output of the filter/buffer unit is taken to one input of an analog-to-digital converter. (*Id.* at 2:39-42.) The analog-to-digital converter operation is controlled by a select/control logic circuit which is driven by timing impulses from a clock circuit. (*Id.* at 2:42-44.) The operation of the clock circuit is determined by an interface circuit which also loads data from the analog-to-digital converter into a microprocessor unit. (*Id.* at 2:45-47.) Outputs from the microprocessor unit are used to control operation of the touch strip input circuit and also to alter terminal functions in response to the strip being touched. (*Id.* at 2:49-51.)

C. Summary of Tiilikainen

Tiilikainen discloses a portable telephone as show in Fig. 1below.

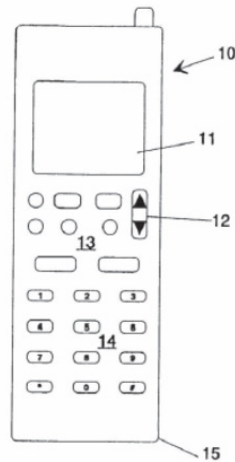


Fig. 1

Tiilikainen describes that the telephone 15 includes a scrolling key 12. (Ex. 1088 at 3:17.) Fig. 2 of Tiilikainen (below) shows that different phone numbers are stored on the phone and can be displayed divided into sections, *i.e.*, columns 25, 26, and 27, that have corresponding headers 21, 22, and 23. (*Id.* at 3:8-10.)

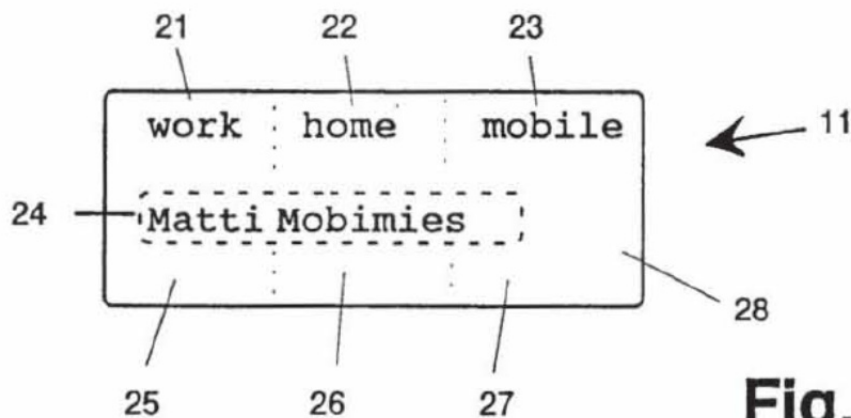


Fig. 2

Tiilikainen describes that when the required number has been brought to the field 24 of the display 28 with scrolling key 12, the user can select the required number by pressing the corresponding column 25, 26, or 27. (*Id.* at 3:16-19.) The selection can be made by pressing with a finger or e.g. with a pen whereby the phone immediately makes a call to the chosen number. (*Id.* at 3:19-22.)

**IV. NO REVIEW SHOULD BE INSTITUTED FOR CLAIMS 1-12 AND 15
BECAUSE TCL FAILS TO SET FORTH A *PRIMA FACIE* CASE OF
OBVIOUSNESS**

Obviousness is a legal determination made on the basis of underlying factual inquiries including (1) the scope and content of the prior art, (2) the differences between the prior art and the claimed invention, (3) the level of ordinary skill in the art, and (4) secondary considerations of nonobviousness, if any. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). TCL failed to address the differences between the prior art and the claimed invention.

Specifically, TCL provides only a cursory discussion of the significant size differences between the touch strips of the display terminal Moore and the handheld—*i.e.*, much smaller—aspect of the claimed invention (claim 1 requires that the radiotelephone comprises housing “configured to be held in a user’s hand”). The Board has denied petitions where, as here, the Petition failed to address the differences between the prior art and the claimed invention. *See, e.g.*,

Synopsys, Inc. v. Mentor Graphics Corp., IPR No. 2012-00041, at *13-15 (Paper No. 16, Feb. 22, 2013) (declining to institute a trial on obviousness where the “petition does not clearly point out the differences between the claimed invention and [the prior art]” and where petitioner failed to “explain why a person of ordinary skill in the art would have found the claimed subject matter obvious in spite of those differences”); *Apple Inc. v. OpenTV, Inc.*, IPR No. 2015-01031, at *13 (Paper No. 10, Oct. 13, 2015) (declining to institute obviousness grounds where the petition did not identify missing limitations in the prior art or how modifications would be made with sufficient specificity).

Because TCL ignored the challenges associated with reducing the size of the touch strips of Moore, TCL has failed to show that the cited prior art references could be successfully combined by a person of skill in the art (“POSITA”) to result in the invention of claims 1-12 and 15 of the ‘931 patent.

The Supreme Court is clear: “Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). In keeping with this mandate, the Board has denied petitions where, as here, the Petition “has not explained

adequately” how the prior art would have led POSITA to modify components to arrive at the claimed subject matter. *See, e.g., Nestlé Healthcare Nutrition, Inc. v. Steuben Foods, Inc.*, IPR2015-00094, Paper 14, at 7, 10-11 (PTAB May 4, 2015) (denying a petition that did not demonstrate how a prior art routing valve could be modified to create the dispensing valve required by the claims).

Accordingly, TCL has failed to present a *prima facie* case of obviousness with respect to these combinations. In sum, TCL has not made a showing that there is a reasonable likelihood that these claims are unpatentable as required under 37 C.F.R. § 42.104(b)(4).

A. Claims 1-11 and 15 Are Not Obvious Over Palatsi in View of Moore

Claim 1 recites the following:

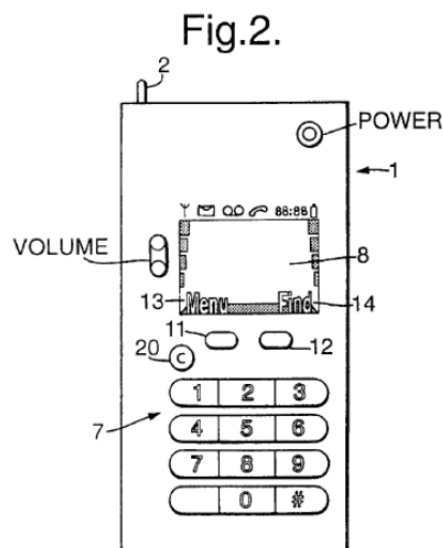
1. A radiotelephone, comprising:
 - a housing having a front surface, a rear surface and first and second side surfaces adjoining respective opposite edges of the front surface and extending from the respective opposite edges of the front surface to respective opposite edges of the rear surface, the housing configured to be held in a user's hand such that the rear surface confronts the user's palm;
 - a radiotelephone communications transceiver, supported by the housing;
 - a display, supported by the housing, that displays an image at the front surface of the housing;
 - a contact-sensitive transducer, supported by the housing and having a contact-sensitive surface disposed at [at least one of the first and second side surfaces] *said front surface*, which produces an output signal [that characterizes] *in response to moving contact of an object along the contact-sensitive surface of the contact-sensitive transducer*; and
 - a controller, responsive to the output signal and operatively associated with the display and the radiotelephone communications transceiver, which controls at least one of the display and the radiotelephone communications transceiver [according to] *and which scrolls displayed rows along an axis of the display based upon the output signal of the contact-sensitive transducer, the controller having a first mode wherein the controller is responsive to contact with the contact-sensitive transducer and a second mode wherein the controller is unresponsive to contact with the contact-sensitive transducer, the second mode being entered in response to an input from a user.*

Notably, the first requirement of Claim 1 is “a housing having a front surface, a rear surface and first and second side surfaces adjoining respective opposite edges of the front surface and extending from the respective opposite edges of the front surface to respective opposite edges of the rear surface, *the housing configured to be held in a user's hand such that the rear surface confronts the user's palm.*”

The Petition (at 23) addresses this particular feature of Claim 1 by noting that Palatsi teaches “[t]here is a need for portable telephones (especially hand-portable telephones) to be smaller to make hem more convenient to carry.”

Patent Owner does not dispute that Palatsi discloses a handheld portable mobile information terminal.

The Petition relies on the combination of Palatsi and Moore to result in “a contact-sensitive transducer, supported by the housing and having a contact-sensitive surface disposed at said front surface, which produces an output signal in response to moving contact of an object along the contact-sensitive surface of the contact-sensitive transducer.” (*Id.* at 27-31.) Specifically, as described above, Palatsi discloses a portable telephone with “soft” keys 11 and 12, as shown in Fig. 2 below.



Palatsi describes that the “soft” keys 11 and 12 can be used for different functions, including scrolling through displayed list items and for selection of one of the items. (Ex. 1087 at 2:64 to 3:8; and Fig. 3.)

However, the “soft” keys of Palatsi, even if they are achieved as touch sensors (*id.* at 4:18), does not perform any action in response to a *moving contact* of an object. The Petition appears to acknowledge this deficiency by relying on Moore for this feature in the following statement (at 28-29):

Furthermore, Moore discloses “a display unit having a display screen and a position sensitive touch strip extending along an edge of the screen, the touch strip having an output in response to its being touched by a user, the nature of the output being dependent on the distance along the strip of the position touched by a terminal user.” (Ex. 1012, 1:42-48.) Moore further describes that “[t]ypical functional keys associated with the touch strips are *soft-key* designation, menu selection, cursor generation, graded control and scrolling.” (*Id.* 3:22-25 (emphasis added).) Furthermore, Moore explains that, “[t]o operate the terminal in [scrolling] mode, the user merely strokes the touch strips along their length in the direction in which the displayed field is to move.” (*Id.*, 4:21-28.) Accordingly, each touch strip of the proposed

modification to Palatsi by Moore is a contact-sensitive transducer that responds to moving contact along its surface and produces an output as “a voltage output which is representative of the distance along it at which it is touched.” (Ex. 1205, ¶ 167; Ex. 1012, 2:22-26.) Voltage is an electrical quantity, and thus, each touch strip of Moore converts a physical contact of an object with the touch strip (i.e., a touch or stroke from a user's finger) to an electrical signal (i.e., voltages representing the distances along the touch strip of the contact point, as the contact point moves). (Ex. 1205, ¶ 167.)

As described above, Moore describes a terminal (*see* Fig. 1 below) that has a cathode ray tube (CRT) unit 10 with a rectangular screen 12 and extending horizontally and vertically along two edges of a bezel surrounding the rectangular screen are touch sensitive strips 16 and 18 respectively. (Ex. 1012 at 2:15-22.)

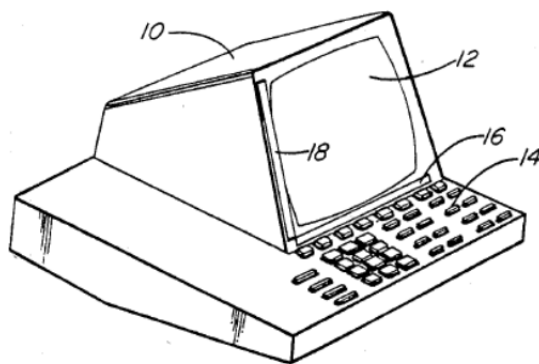
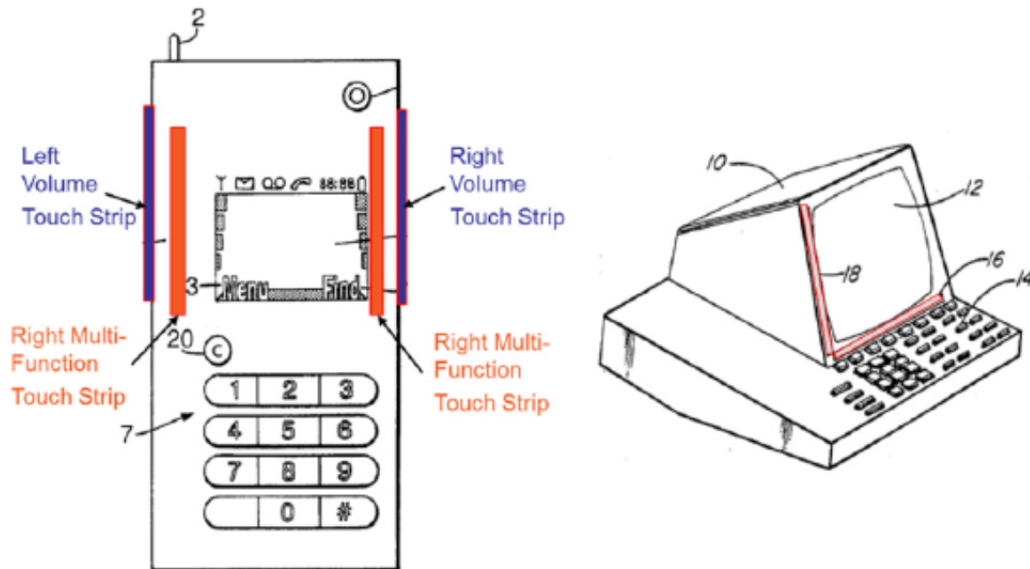


FIG. 1

The Petitioner's alleged combination of Palatsi and Moore relies on applying the touch sensitive strips 16 and 18 in Moore to the portable telephone in Palatsi as illustrated in the Petition below (at 20).



(Demonstrative Fig. 2 (Palatsi modified by Moore).)

This alleged combination shown in the Petitioner's demonstrative above appears to assume that the touch-sensitive strips of Moore are devices that can literally be stripped from their native environment and pasted onto the portable telephone of Palatsi. What is clearly missing from the above-shown combination is how the hardware used to support and operate the touch-sensitive strips in Moore has been migrated to the portable telephone of Palatsi. As described above, Fig. 3 of Moore shown below illustrates the hardware used to achieve the operation of the touch-sensitive strips 16 and 18.

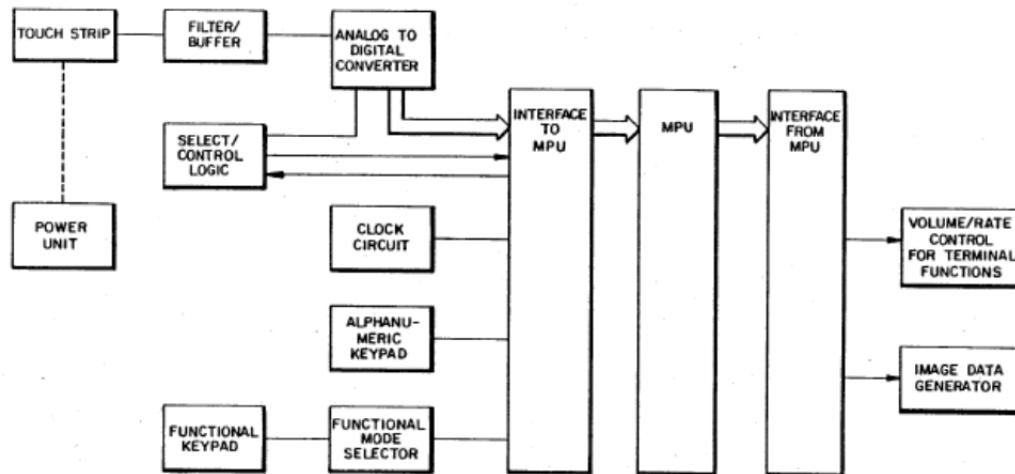


FIG. 3

In particular, Moore describes that the touch strip has its own power supply to establish the voltage gradient along the resistive substrate. (*Id.* at 2:37-39.)

The additional hardware used in Moore for operation of the touch-sensitive strips are a filter/buffer unit, an analog-to-digital converter, a select/control logic circuit which is driven by timing impulses from a clock circuit, an interface circuit, and a microprocessor unit. (*Id.* at 2: 37-47.)

Thus, Moore ***only discloses*** touch-sensitive strips as integrated into computer terminal device large enough to support a cathode ray tube (CRT) display while requiring a dedicated power supply and hardware. There is no disclosure or suggestion at all in Moore as to how the functionality or structure of the touch-sensitive strips can be incorporated into a handheld portable telephone,

such as that disclosed by Palatsi, which already has existing hardware contained in the housing. (Ex. 1087 at Fig. 1.)

Petitioner's argument relies mainly on analyzing the functionality of Palatsi and Moore in their separate contexts, and then reaching the conclusion that the features of Moore would be desirable on the mobile phone of Palatsi. However, the requirements of *KSR* are not met in their analysis, despite TCL's citations to this case.

First, the variations Moore would add to Palatsi are ***not predictable*** to a POSITA. As mentioned above, Moore only provides a description of the hardware needed for its touch-sensitive strips in a stand-alone device that is large enough to support a CRT.

Given the clear and self-evident size and power constraints of mobile phone technology compared to display terminal technology, ***it is not predictable at all*** that incorporating any extra hardware into a mobile phone would not affect performance or create a technical challenge that requires undue experimentation to mitigate.

Additionally, Moore and Palatsi are clearly ***not similar devices***. A mobile phone and a display terminal may have similar features, but the similarities end—especially where size is concerned.

The significance of the effect of size in the portable telephone industry is described in Palatsi itself, which describes the following.

Many portable telephones are controlled through a series of menus. Each menu consists of a series of menu items which can be selected by a user. The selecting of an item controls the telephone, either to cause it to present another menu (for example if the menus are organised in a hierarchical, branching structure) or to control other features of the telephone (for example to begin a telephone call, store information in a memory or increase the telephone's ringing volume). Typically, three keys are provided to allow the user to operate the menu system. One key causes the next menu item to be displayed, another key causes the preceding menu item to be displayed, and the third key is used to select the currently-displayed item. This is a form of "scroll-and-select" menu system.

There is a need for portable telephones (especially hand-portable telephones) to be smaller, to make them more convenient to carry, and as they become smaller it is necessary to reduce the size of their keypads. However, this has the risk of making the telephones less easy to use; either because the keys are too small or, if fewer keys are

used, because a more basic but less user-friendly control system has had to be adopted.

(Ex. 1087 at 1:7-28.)

Thus, Palatsi itself recognizes that even a feature such a dedicated keys to perform scrolling and selection affects the ability to reduce the size of the portable telephone.

Therefore, the Petition's failure to articulate how Palatsi's handheld mobile phone would actually be modified is a fatal omission, especially because Claim 1 explicitly requires "a housing having a front surface, a rear surface and first and second side surfaces adjoining respective opposite edges of the front surface and extending from the respective opposite edges of the front surface to respective opposite edges of the rear surface, *the housing configured to be held in a user's hand such that the rear surface confronts the user's palm.*"

It has long been understood that claim elements cannot be analyzed in a vacuum, and in determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782 (Fed. Cir. 1983). The Petition

clearly violates this principle because virtually *no effort* is made to provide even a half-hearted guess as to how a POSITA would successfully combine Palatsi's handheld phone with the touch strip elements of Moore, while maintaining the "handheld" aspect.

Instead, Petitioners propose an overly naïve combination by forcefully cramming the Moore's touch strips into Palatsi's handheld mobile telephone without even a tangential discussion on numerous difficulties relating to miniaturizing electronic equipment, such as power consumption, physical implementation, cost, and integrated circuit constraints. This combination, even if possible, will yield unpredictable results without a POSITA performing undue experimentation.

The Petition expends a lot effort explaining how "contact-sensitive technologies" were well known leading up to the effective priority date of the '931 patent. (Petition at 5-7.) Yet, when it comes to the most apparent technical challenge facing a POSITA in the mobile telephone arts, *i.e.*, adding more functionality to a device with a clear size constraint, Petitioners have completely failed to provide any explanation as to how this would be achieved.

It is common sense that if a POSITA is given two different devices and asked merely to "combine them," the most predictable outcome is that the devices

will take up the amount of space of both devices combined. What is clearly *unpredictable* is combining two devices, one being a handheld and the other one not being readily handheld, and *maintaining the size of the handheld device*—as required by the claims. *Because the size constraint is an explicit requirement of the claim, this deficiency cannot be ignored.* Because Petitioners fail to address this claim element when asserting the combination of prior art references, all claim elements of claim 1 have not been properly shown to be disclosed in the asserted combination, and the Petition can be summarily denied with respect to claim 1.

Claims 2-11 and 15 depend directly or indirectly from independent claim 1. Since the Petition fails to make a *prima facie* case of obviousness for claim 1 based on Palatsi and Moore, the combination necessarily fails to render obvious claims 2-11 and 15 depending therefrom.

Even assuming, *arguendo*, that the Board agrees that Palatsi and Moore can be properly combined in some manner, but with the size requirement of the claim missing, claim 1 and those dependent therefrom are still not obvious, and the Petition should be denied. The Federal Circuit has held that where the only difference between the prior art and the claims was the size requirement in the claim, the claimed device is not patentably distinct from the prior art device *if the device having claimed relative dimensions would not perform differently than*

the prior art device. *Gardner v. TEC Syst., Inc.*, 725 F.2d 1338, 1349 (Fed. Cir. 1984) (affirming that dimensional limitations are not patentably significant where the only difference between the prior art and the claims are the relative dimensions and there is no change in performance or operation). The opposite is true here: the handheld telephone of claim 1 and those dependent therefrom ***does*** perform differently than the large touch strip display terminal of Moore, and thus, claim 1 and those dependent therefrom are not obvious.

Portability and convenience are performance requirements related to user experience that are completely different in mobile phones compared with computers, resulting in very different performance and operation. For example, there are objective metrics readily apparent in measuring the performance differences between mobile phones and laptops, such as weight, size, and the ability to use with a single hand. Therefore, in this case, the performance of a device that meets the “handheld” requirement of Claim 1 is clearly different than the performance of a device that does not meet this requirement (such as a display terminal). As such, the Petition should be denied for failing to show that claim 1 and those dependent therefrom are not obvious even if Palatsi and Moore are combined, consistent with the rule in *Gardner*.

B. Claim 12 Is Not Obvious Over Palatsi in View of Moore and Tiilikainen

Claim 12 depends indirectly from independent claim 1. As described above, Tiilikainen is directed a portable telephone with a touch-sensitive display 11 and a scrolling key 12 as shown in Fig. 1 below.

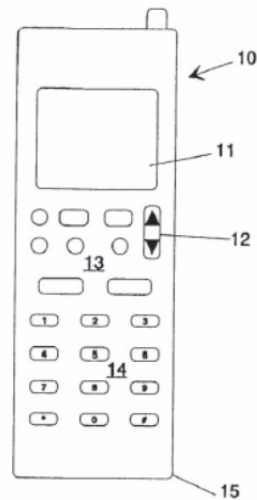


Fig. 1

Tiilikainen describes using the scrolling key 12 to scroll through stored telephone numbers, and when the required number has been brought to the field 24 (*see* Fig. 2), the user can select the required number by pressing the display (with a finger or a pen) at the corresponding column 25, 26, or 27, whereby the phone immediately makes a call to the chosen number. (*Id.* at 3:19-22.)

However, the scrolling key 12 of Tiilikainen is merely similar to the “soft” keys 11 and 12 of Palatsi, in which a single touch operation on the

scroll buttons causes the scrolling operation. Similar to the deficiency of Palatsi, Tiilikainen does not describe performing the scrolling by way of a *moving contact* of an object along the surface of the touch screen. Therefore, Tiilikainen does not disclose or suggest anything to remedy the deficiencies of combining Palatsi and Moore discussed above. As such, Palatsi, Moore, and Tiilikainen fail to render obvious claim 12.

V. CONCLUSION

For the foregoing reasons, the petition should be denied.

Respectfully submitted,
Oblon, McClelland, Maier &
Neustadt, LLP

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/W. Todd Baker/
W. Todd Baker
(Reg. No. 45,265)
Attorney for Patent Owner
TELEFONAKTIEBOLAGET LM
ERICSSON

Customer Number
22850
Tel. (703) 413-3000
Fax. (703) 413-2220

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies service of
PATENT OWNER'S PRELIMINARY RESPONSE on the counsel of record for
the Petitioner by filing this document through the Patent Review Processing
System as well as delivering a copy via electronic mail to the following address:

Stephen S. Korniczky
Martin R. Bader
David A. Randall
Nam H. Kim
Hector A. Agdeppa
Sheppard Mullin Richter & Hampton LLP
12275 El Camino Real, Suite 200
San Diego, California 92130
LegalTm-TCL-IPRs@sheppardmullin.com

Dated: November 23, 2015

/W. Todd Baker/
W. Todd Baker (Reg. No. 45,265)